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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,736	12/29/2000	Migaku Takahashi	OSP-10239	4239
466	7590	04/01/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			UHLIR, NIKOLAS J	
			ART UNIT	PAPER NUMBER

1773

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/720,736

Applicant(s)

TAKAHASHI ET AL.

Examiner

Nikolas J. Uhlir

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: it is drawn to the non-entered amendment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 1-3, 5-15 and 25-41.

Claim(s) rejected: 1-3, 5-15 and 25-41.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Interview Summary


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Continuation of box 2: The proposed amendment will not be entered because it creates a number of new combinations that require further search and consideration to determine patentability. Specifically, all of the claims that are dependent on claim 1 would be required to utilize a FeC martensite film having an α' principal phase and an easy axis in plane with the substrate. Though the limitations of claim 1 would not require further search and or consideration, all of the dependent claims would contain new issues that were not earlier presented and which require further search and consideration to determine patentability.

Though the examiner recognizes that in the interview held on 03/04/2004 that the examiner indicated that it was likely that the prior art would be overcome as a result of an evidentiary reference brought in by the applicant's representative. However, further consideration of that reference has revealed the reference to be unpersuasive. Specifically, the evidentiary reference was asserted to show that because of the temperature at which Takahashi is formed the FeC film of Takahashi will necessarily have an easy axis perpendicular to the film surface. However, the evidentiary teaching is directed to the formation and orientation of a $\text{Ho}_2\text{Co}_{15}\text{Si}_2$ alloy, which is wholly unrelated to the FeC film of Takahashi. Accordingly, the evidentiary reference cannot be considered to teach that the FeC films of Takahashi will necessarily have a perpendicular easy axis. Thus, applicant's arguments are not considered to be sufficient to overcome the applied prior art. Therefore, if the proposed amendment were entered, it would not render the case allowable and would create a number of new combinations that would require further search and/or consideration to determine patentability. For

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these very same reasons, the proposed amendment does not simplify the issues for appeal.


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700